No. 89-243

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1989

ELI LILLY AND COMPANY,

Petitioner,

v.

MEDTRONIC, INC.,

Respondent.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

MEMORANDUM OF RESPONDENT MEDTRONIC, INC. IN OPPOSITION TO THE MOTION OF INTELLECTUAL PROPERTY OWNERS, INC. FOR LEAVE TO FILE BRIEF AMICUS CURIAE IN SUPPORT OF THE PETITION FOR CERTIORARI

Philip S. Johnson
Counsel of Record
Gary H. Levin
Albert W. Preston
Henrik D. Parker
WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS
One Liberty Place, 46th Floor
Philadelphia, PA 19103
(215) 568-3100
Counsel for Respondent

Of Counsel:
Ronald E. Lund
Joseph F. Breimayer
Medtronic, Inc.
7000 Central Avenue, NE
Minneapolis, Minnesota 55432

PACKARD PRESS / LEGAL DIVISION, 1617 JFK BOULEVARD, PHILA., PA 19103 (215) 563-9080

TABLE OF AUTHORITIES

Cases:	Page
Roche Prods., Inc. v. Bolar Pharmaceutical Co., 733 F.2d 858 (Fed. Cir.), *cert. denied*, 469 U.S. 856 (1984)	2
Statutes:	
35 U.S.C. § 271(e)	2
35 U.S.C. § 271(e)(1)	3
35 U.S.C. § 156(b)	3
Other Authorities:	
Resolution 101-4, A.B.A. Sec. Pat., Trademark & Copyright L., 1988 Summary of Proceedings	3

No. 89-243

IN THE

SUPREME COURT OF THE UNITED STATES

October Term 1989

ELI LILLY AND COMPANY

Petitioner,

v.

MEDTRONIC, INC.

Respondent.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

MEMORANDUM OF RESPONDENT MEDTRONIC, INC. IN OPPOSITION TO THE MOTION OF INTELLECTUAL PROPERTY OWNERS, INC. FOR LEAVE TO FILE BRIEF AMICUS CURIAE IN SUPPORT OF THE PETITION FOR CERTIORARI

Respondent, Medtronic, Inc., hereby opposes the motion of the Intellectual Property Owners, Inc. ("IPO") for leave of Court to file a brief *amicus curiae* in support of the petition for a writ of certiorari.

IPO is a lobbying group whose members are patent owners having a vested interest in enhancing the value of their patent properties (IPO Brief at 2). IPO candidly admits that its "government relations program in Washington, D.C." includes the support of "legislation to strengthen protection available under the U.S. patent . . . laws" (IPO Brief at 2). With the presentation of IPO's motion, IPO now extends its lobbying efforts to this Court.

Although the IPO implies that its brief represents the widely held beliefs of its membership, no poll was taken of its membership at large to determine whether they agreed or disagreed with the content of this brief.[1] Apparently, this brief was solicited by petitioner, Eli Lilly & Company ("Lilly").[2] It is understandable that IPO would grant such a request in view of petitioner Lilly's status as an active member and contributor to IPO.

The views of IPO's lobbyists are not shared by other, more prominent organizations in this field. The American Bar Association, Section on Patents Trademarks and Copyrights considered the intended scope of the experimental use exception in the wake of *Roche Prods., Inc. v. Bolar Pharmaceutical Co.*, 733 F.2d 858 (Fed. Cir.), *cert. denied*, 469 U.S. 856 (1984), and the enactment of 35 U.S.C. § 271(e), and adopted the following resolution:

> RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle an exemption from infringement for activities conducted solely for experimental or research purposes whether or not such activities are conducted by a commercial organization.

Resolution 101-4, passed on August 8, 1988, after full debate as to Subject 5: EXPERIMENTAL USE AFTER ROCHE V. BOLAR; printed in 1988 Summary of Proceedings, Section of Patent, Trademark and Copyright Law, American Bar Association, Chicago, Illinois, at 24.

Nor would filing of the proposed brief of the IPO materially assist the Court in deciding whether to grant *certiorari* in this case. The IPO raises issues never briefed or considered below. For example, the IPO brief focuses on agricultural chemicals regulated by the Environmental Protection Agency (IPO Brief at 5), nothwithstanding the fact that the record below is virtually devoid of any mention of them. In arguing that these chemicals

1. A copy of the proposed brief was forwarded only to members of the board of the IPO for comment.

2. Counsel for IPO, Mr. Wamsley, explained Lilly's role in prompting the filing of this brief in a telephone conference with Medtronic's counsel, Mr. Levin, during which Medtronic declined to consent to the present motion.

are affected by the Federal Circuit decision, IPO overlooks the fact that the Federal Circuit used the phrase "*any type* of patented invention" only in conjunction with the express limitation that the exempted activities be " 'solely' for the restricted uses stated [in 35 U.S.C. 271(e)(1)]" (Pet. App. 7a). Agricultural chemicals are *not* regulated under "a Federal law which regulates . . . drugs or veterinary biological products." 35 U.S.C. 271(e)(1). Although IPO contends that agricultural chemicals may be affected by the Federal Circuit decision, neither of the parties below have contended that agricultural chemical products are entitled to receive statutory patent extensions under 35 U.S.C. 156(b), or that their EPA testing should be construed as being within the Section 271(e)(1) exemption. Presentation of these extraneous issues to the Court at this time is simply unnecessary to a decision on the merits of the pending petition.

For the reasons set forth above, the IPO motion for leave to file a brief *amicus curiae* should be denied.

Respectfully submitted,

Philip S. Johnson
Counsel of Record
Gary H. Levin
Albert W. Preston
Henrik D. Parker
WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS
One Liberty Place-46th Floor
Philadelphia, PA 19103
(215) 568-3100
Counsel for Respondent

Dated: October 1, 1989

Of Counsel:
Ronald E. Lund
Joseph F. Breimayer
Medtronic, Inc.
7000 Central Avenue, N.E.
Minneapolis, Minnesota 55432